

REMARKS

The Office Action dated August 24, 2009, (“Office Action”) has been received and carefully considered. Claims 1-8, 21-27, and 29-36 are pending in this application. By this Amendment, claims 1, 21, 29, and 30 are amended and claims 9 and 10 are canceled without prejudice or disclaimer to the subject matter set forth therein, with claims 11-20 and 28 previously canceled.

No new matter is added by this Amendment. Support for the claim amendments may be found in originally filed claims 9 and 10 and in paragraphs [0062] - [0065] and [0090] of the published application (2004/0093242), for example.

Reconsideration and allowance in view of the following remarks are respectfully requested.¹

A. The Rejection under 35 U.S.C. 101

On page 2 of the Office Action, claims 1-10, 21-27, and 29-36 were rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. This rejection is hereby respectfully traversed.

“A claimed process is patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or

¹ As Applicant’s remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicant’s silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, assertions regarding official notice, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

thing.” In re Bilski, 545 F.3d 943, 954 (Fed. Cir. 2008). That is, “a claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed.” Id. Also, “a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article.” Id. Thus, “a claim that is tied to a particular machine or brings about a particular transformation of a particular article does not pre-empt all uses of a fundamental principle in any field but rather is limited to a particular use, a specific application.” Id. at 957. However, even if a claim recites a specific machine or a particular transformation of a specific article, the recited machine or transformation must not constitute mere “insignificant postsolution activity.” Id.

Regarding claims 1-10, the Office Action alleges that the claims appear to be software per se without any structural requirements. Applicant respectfully disagrees and submits that claims 1-10 are tied to a particular machine or apparatus and not software per se. In particular, Applicant submits that independent claim 1 recites an automated system comprising a network interface, a user interface, and processing tools. Also, Applicant has amended independent claim 1 to more clearly recite a method that: (1) is tied to a particular machine or apparatus, or (2) transforms a particular article into a different state or thing. In particular, Applicant respectfully submits that amended independent claim 1 recites a method that is tied to various interfaces and tools of a system. Furthermore, Applicant directs the Examiner to the case law set forth in In re

Beauregard, 53 F.3d 1583 (Fed. Cir. 1995) and Ex parte Lundgren, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005), and others, which clearly provide a patentable subject matter basis for claim 1.

Regarding claims 21-27 and 29-36, Applicant has amended independent claims 21 and 30 to more clearly recite a method that: (1) is tied to a particular machine or apparatus, or (2) transforms a particular article into a different state or thing. In particular, Applicant respectfully submits that amended independent claims 21 and 30 recite a method that is tied to various interfaces and tools of a system. Furthermore, Applicant directs the Examiner to the case law set forth in In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995) and Ex parte Lundgren, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005), and others, which clearly provide a patentable subject matter basis for independent claims 21 and 30.

In view of the foregoing, Applicant respectfully requests that the aforementioned non-statutory subject matter rejection of claims 1-10, 21-27, and 29-36 be withdrawn.

B. The Rejection under 35 U.S.C. 112, Sixth Paragraph

On page 4 of the Office Action, claims 1, 7, 8, 10, 21, and 23 are being treated under 35 U.S.C. 112, 6th paragraph.

Applicant submits that under 35 U.S.C. § 112, sixth paragraph, provides, “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” Claims 1, 7, and 8, recite a

“system” comprising several “means” for performing specific functions which should be to cover the corresponding structures described in the specification, i.e., those disclosed in the specification which correspond to the functions recited in the claim. Thus, claims 1, 7, and 8 recite a system, in a manner specifically authorized by Congress under 35 U.S.C. § 112, sixth paragraph, and thus is directed to statutory subject matter. Also, claims 21 and 23, recite “an automated system” comprising several “means” for performing specific functions which should be to cover the corresponding structures described in the specification, i.e., those disclosed in the specification which correspond to the functions recited in the claim. Thus, claims 21 and 23 recite a system, in a manner specifically authorized by Congress under 35 U.S.C. § 112, sixth paragraph, and thus is directed to statutory subject matter.

C. The Rejection under 35 U.S.C. 112, Second Paragraph

On page 5 of the Office Action, claims 1, 7, 21, and 30 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the invention. This rejection is hereby respectfully traversed.

Regarding claims 1, 21, and 30, Applicant respectfully submits that Applicant has amended claims 1, 21, and 30 and therefore the aforementioned indefiniteness rejection of claims 1, 7, 21, and 30 has become moot in view of the amendments to claims 1, 21, and 30.

In view of the foregoing, Applicant respectfully requests that the aforementioned indefiniteness rejection of claims 1, 7, 21, and 30 be withdrawn.

D. The Rejection under 35 U.S.C. 103

On page 6 of the Office Action, claims 1-7, 9, 21-26, and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,343,271 to Peterson et al. (“Peterson”) in view of U.S. Patent Application Publication 2003/0167220 to Schoen et al. (“Schoen”) and further in view of U.S. Patent No. 5,191,522 to Bosco et al. (“Bosco”) Applicant respectfully traverses this rejection.

As set forth in M.P.E.P 706.02(j), 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. M.P.E.P 706.02(j) indicates that after indicating that the rejection is under 35 U.S.C. 103, the Examiner should set forth in the Office Action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P 706.02(j) references the well known requirements of Graham v. John Deere. Further, M.P.E.P 706.02(j) notes that it is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply.

Regarding claim 1, the Office Action asserts various alleged teachings of Peterson, Schoen, and Bosco. Applicant respectfully disagrees. However, in order to forward the present application toward allowance, Applicant has amended claim 1 to more specifically define the claimed invention. In particular, Applicant respectfully submits that Peterson, Schoen, and Bosco, either alone or in combination, fail to disclose, or even suggest, an automated system for managing insurance information and processing insurance claims, the automated system comprising: “a benefits calculation engine for determining benefits payable, the benefits calculation engine comprising a plurality of formulas, each formula corresponding to specific disablement information such that there is an association respectively between a formula and specific disablement information, wherein each of the plurality of formulas includes at least one section having 1) calculation steps for limiting benefit payments to coverage maximums and for calculating an elimination period in days and a deductible in dollars and 2) traffic regulating steps to determine when to run the at least one section, the benefits calculation engine calculates benefits for multiple reimbursement products available for multiple disablement scenarios, and the benefits calculation engine further comprises means for accessing a benefit code that corresponds respectively to each reimbursement product to determine the benefits payable,” and “claim and financial reporting tools for performing financial reporting, claim valuation, statistical analysis, partnership reporting, bank reconciliation, and check writing,” as recited in amended claim 1 (emphasis added). The Office Action reflects that Peterson fails to teach features of the claimed invention. Specifically, the Office Action asserts that Peterson et al. **fails to specifically point out:**

the benefits calculation engine comprising a plurality of formulas, each formula corresponding to specific disablement information, wherein the

benefits calculation engine calculates benefits for multiple reimbursement products available for multiple disablement scenarios.

Thereafter, the Office Action attempts to cure such deficiencies with the teachings of Schoen. Specifically, the Office Action asserts:

However, Schoen et al. teaches a system "to enable disability issuing insurance carriers to perform data processing, calculation of coverage and or benefits, premium, and/or other consideration, record keeping and other requisite functions attendant to offering and administering group or individual disability insurance" (see: Schoen et al., paragraph 39); furthermore, it is possible to "set up multiple plans based upon different participation criteria" and the "system must be capable to tracking each plan separately yet combine them for various purposes" (see: Schoen et al., paragraph 258). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Peterson et al. and Schoen et al. with the rationale of providing the proper financial means to implement an insurance policy and to allow "insurers ... to customize reports based upon different combinations of plans" (see: Schoen et al., paragraph 258).

However, as discussed in Applicant's prior Response, the Office Action has clearly identified a deficiency of Peterson, i.e., that Peterson fails to specifically point out (i.e., fails to teach), the benefits calculation engine comprising a plurality of formulas, each formula corresponding to specific disablement information. While the Office Action then proposes to modify Peterson with teachings of Schoen, the Office Action indeed still fails to cure this acknowledged deficiency of Peterson. Furthermore, Bosco fails to remedy the deficiencies of Peterson and Schoen.

In other words, even if it were obvious to modify Peterson with Schoen and Bosco as alleged in the Office Action, which Applicant does not admit, such would still fail to cure the deficiencies of Peterson acknowledged in the Office Action. Thus, the 35 U.S.C. 103 rejection is deficient.

The present Office Action further clarifies the manner in which Schoen allegedly cures the deficiencies of Peterson. That is on page 17, the Office Action asserts:

... however, Schoen teaches a system for disability insurance carriers that can process data by calculating coverage and benefits for multiple plans based on different participation criteria. It is understood and obvious that calculating coverage for multiple plans with different participation criteria (or even a single plan) **are associated with a plurality of coverage and benefits calculations**, which reads on the plurality of formulas **corresponding** to specific disablement information and the benefit calculations for multiple reimbursement products for multiple scenarios. ...

(emphasis added)

However, such assertions on their face are deficient vis-à-vis the claimed features, as recited in claim 1. That is, claim 1 does not recite “the plurality of formulas **corresponding** to specific disablement information” as concluded (by the Office Action) that Peterson teaches (see above). Rather, the features of claim 1 now recite and previously recited that “each formula corresponding to specific disablement information”. Thus, such claim language requires a level of association between a formula and specific disablement information. The Office Action does not even allege that Peterson discloses such. Rather, the Office Action inappropriately simplifies the claimed invention by asserting the general statement that calculating coverage for multiple plans with different participation criteria (or even a single plan) are associated with a plurality of coverage and benefits calculations.

Applicant submits that claim 1 defines patentable subject matter at least for the reasons set forth above. Further, independent claims 21 and 30 recite patentable subject matter for at least some of the reasons similar to those set forth above.

Applicant submits that the various dependent claims recite patentable subject matter for at least their various dependencies on the independent claims, as well as for the additional features such dependent claims recite.

Withdrawal of the 35 U.S.C. 103 rejection is requested.

E. The Further 35 U.S.C. 103 Rejection

On page 14 of the Office Action, claims 8, 10, and 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,343,271 to Peterson et al. (“Peterson”) in view of U.S. Patent Application Publication 2003/0167220 to Schoen et al. (“Schoen”) in view of U.S. Patent No. 5,191,522 to Bosco (“Bosco”) and further in view of Official Notice. Applicant respectfully traverses this rejection.

Applicant submits that the further modification of Peterson based on the teachings of Schoen and Bosco, and the asserted official notice, fails to cure the deficiencies of the rejection, as discussed above. That is, Applicant submits that even if it were obvious to modify Peterson based on the teachings of Schoen, Bosco, and the Official Notice, as asserted in the Office Action, which is not admitted by Applicant, such combination of applied art would still fail to fairly teach or suggest the claimed invention.

Further, Applicant submits that such dependent claims recite patentable subject matter for at least reasons similar to those set forth above, as well as the additional features such dependent claims recite.

Applicant hereby makes no admission as to the propriety of the various assertions of Official Notice, as set forth in the Office Action, and reserves such right. Rather, Applicant submits that the claims are allowable for the reasons as set forth above.

Withdrawal of the 35 U.S.C. 103 rejection is requested.

F. The Further 35 U.S.C. 103 Rejection

On page 17 of the Office Action, claims 30-36, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,343,271 to Peterson et al. ("Peterson") in view of U.S. Patent Application Publication 2003/0167220 to Schoen et al. ("Schoen") and further in view of Official Notice. Applicant respectfully traverses this rejection.

Applicant submits that the further modification of Peterson based on the teachings of Schoen, and the asserted official notice, fails to cure the deficiencies of the rejection, as discussed above. That is, Applicant submits that even if it were obvious to modify Peterson based on the teachings of Schoen and the Official Notice, as asserted in the Office Action, which is not admitted by Applicant, such combination of applied art would still fail to fairly teach or suggest the claimed invention.

Further, Applicant submits that such dependent claims recite patentable subject matter for at least reasons similar to those set forth above, as well as the additional features such dependent claims recite.

Applicant hereby makes no admission as to the propriety of the various assertions of Official Notice, as set forth in the Office Action, and reserves such right. Rather, Applicant submits that the claims are allowable for the reasons as set forth above.

Withdrawal of the 35 U.S.C. 103 rejection is requested.

G. Conclusion

For at least the reasons outlined above, Applicant respectfully asserts that the application is in condition for allowance. Favorable reconsideration and allowance of the claims are respectfully solicited.

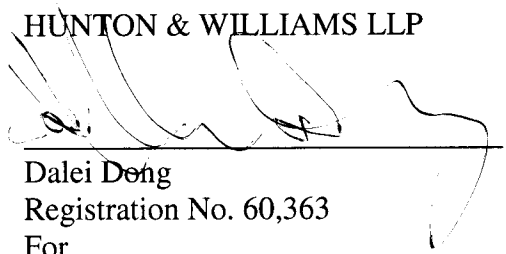
For any fees due in connection with filing this Response the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: December 24, 2009

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